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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/230,111	05/17/1999	TAKA-AKI SATO	48962-A-PCT-	4836

7590

10/31/2003

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EXAMINER

BLANCHARD, DAVID J

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 10/31/2003

3/

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/230,111

Applicant(s)

SATO ET AL.

Examiner

David J Blanchard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/14/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 121-141 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 121-141 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 26.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The request filed on 4/14/2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/230,111 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claims 121-141 are under examination.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The filing of the CPA as Paper #30 (4/14/2003) does not present any arguments or amendments to the claims.

#### ***Response To Arguments:***

5. Claims 121-141 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is MAINTAINED because the filing of the CPA does not present any arguments or amendments to the claims.
6. Claims 121-141 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods for screening for compounds that disrupt the binding of Fas with FAP, does not reasonably provide enablement for methods for screening for compounds that disrupt the binding of a CD4 receptor, a p75 receptor, a serotonin receptor, a serotonin 2B receptor, a NMDA receptor, or a K<sup>+</sup> channel, or a

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signal transducing protein that is a peptide consisting essentially of 3-13 amino acids having at its carboxyl terminus the amino acid sequence (S/T)-X-(V/I/L) (SEQ ID NO: 4) with a cytoplasmic protein containing the sequence (G/S/A/E)-L-G-(F/I/L) (SEQ ID NO:

1). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims is MAINTAINED because the filing of the CPA does not present any arguments or amendments to the claims.

7. The rejection of claims 121-132 and 139-141 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention is MAINTAINED because the filing of the CPA does not present any arguments or amendments to the claims.

8. Claims 121-132 and 139-141 are rejected under 35 U.S.C. 102(e) as being anticipated by Reed et al (U.S. Patent 5,876,939; issued March 2, 1999; effective U.S. filing date March 27, 1995) is MAINTAINED because the filing of the CPA does not present any arguments or amendments to the claims.

**Conclusion**

9. No claim is allowed.

10. This is a CPA of applicant's earlier Application No. 09/230,111. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

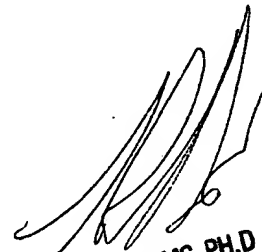
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Blanchard whose telephone number is (703) 605-1200. The examiner can normally be reached at (703) 605-1200 from 8:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Anthony C. Caputa, can be reached at (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.

Official papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The official fax number for Group 1600 where this application or proceeding is assigned is (703) 872-9306.

Respectfully,  
David J. Blanchard  
703-605-1200



LARRY R. HELMS, PH.D  
PRIMARY EXAMINER